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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/666,164	06/19/96	GENISE	T 94-RTRN-387

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PM31/0508

EXAMINER

WRIGHT, D

ART UNIT	PAPER NUMBER
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3622

17

DATE MAILED: 05/08/98

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/666,164

Applicant(s)
Genise

Examiner
Dirk Wright

Group Art Unit
3622



☒ Responsive to communication(s) filed on Aug 29, 1997

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-143 is/are pending in the application.

Of the above, claim(s) 35-47, 51, 52, and 58-143 is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1, 6, 8, 14, 16-18, 20, 22-24, 26-30, 33, and 54-57 is/are rejected.

☒ Claim(s) 2-5, 7, 9-13, 15, 19, 21, 25, 31, 32, and 34 is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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The Amendment filed August 29, 1997 was entered.

1. Newly submitted claims 35-47, 51, 52, 58-143 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

a. Claims 35 and 43, an operator input to request torque elimination is recited. This is distinct from applicant's claims 24-30, where a sensor 122 is used to signal the controller that the shift lever is about to be moved to neutral. There is no manually actuated switch for requesting torque elimination. The term "torque elimination" means that the engine is controlled to alter the driving torque across a dog tooth clutch (which connects a particular gear to a shaft) so that the operator may uncouple the clutch and shift to neutral. The operator requests torque elimination prior to shifting to neutral. Applicant's recited sensor 122 tells the controller that the operator is about to shift to neutral. The controller then does several things, including eliminating torque. The request for torque elimination is not a separate function in the originally claimed invention.

b. Claims 79, 83, 86, 91, 100, 105, 106, 107, 132, 139, 140, 141, 142 and 143 an operator manipulated switch for telling the controller whether the next shift is going to be an upshift or a downshift, or shift to a particular gear ratio, is recited. This is also not found in the original claims. It is distinct because having a sensor 122 to indicate that the operator is going to move the shift lever to neutral is different then having a switch to indicate that the operator is going to shift to a higher or lower gear, or to any particular gear. Moving the lever to neutral does not necessarily mean a shift is going to occur.

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c. In claims 109, 129, 131, a means to determine a forward target gear ratio is recited. This is new and distinct because the original claims only specified that a sensor 122 indicated to the controller that the operator was going to shift to neutral. There is no means to perform this function in the original claims.

d. In claims 58 and 75 a manually operated switch to indicate an intent to shift is recited. There is no such switch in the original claims. The means recited in the last paragraph of original claim 24 is a sensor, not a manually actuated switch.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, these claims have been withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

2. The petition to correct the inventorship, by adding Mr. McReynolds, of this nonprovisional application under 37 CFR 1.48(a) is deficient because:

The verified statement of Mr. Genise does not explain whether the inventor had reviewed and understood the contents of the specification including the claims, and whether he had reviewed the oath or declaration prior to its execution and if so how the error had occurred in view of such reviews. Without such showing of circumstances, no basis exists for a conclusion that the application had been made in the name of the original applicant “through error without and deceptive intention,” and no foundation is supplied for a ruling that the amendment to add Mr. McReynolds was “diligently made.”

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3. The petition to correct the inventorship, by adding Mr. Markyvech, in this nonprovisional application under 37 CFR 1.48(c) requesting addition of an inventor is deficient because:

a. It lacks the required fee under 37 CFR 1.17(I). A separate fee is required for adding an inventor under a different rule.

b. There is no verified statements of fact from the original named inventor regarding Mr. Markyvech. A separate statement and petition is required.

4. The attempt to incorporate subject matter into this application by reference to at least US Patents 5,508,916; 4,648,290; 5,053,961; 4,595,986; 4,722,248; 5,435,212 and 5,509,867 is improper because they all incorporate "essential material," as defined in MPEP 608.01(p).

5. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120 as follows:

The second application (which is called a continuing application) must be an application for a patent for an invention which is also disclosed in the first application (the parent or provisional application); the disclosure of the invention in the parent application and in the continuing application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *In re Ahlbrecht*, 168 USPQ 293 (CCPA 1971).

Claims 1-23 of this application recite a method of fueling an engine that is not disclosed any of the prior applications.

6. This application repeats a substantial portion of prior Application No. 08/649,830, filed April 30, 1996, and adds and claims additional disclosure not presented in the prior application.

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Since this application names an inventor or inventors named in the prior application, it may constitute a continuation-in-part of the prior application. Should applicant desire to obtain the benefit of the filing date of the prior application, attention is directed to 35 U.S.C. 120 and 37 CFR 1.78.

7. Prosecution is suspended on claims 48-50 and 53 pending resolution of the issues raised herein. These claims will be forwarded to the Board of Appeals for consideration of the First Request for Interference.

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

9. Claims 1, 14, 16-18, 20, 22-24, 26-30, 33 and 54-57 are rejected under 35 U.S.C. 102(e) as being anticipated by Palmeri et al. '558.

Palmeri discloses a combined system for assisting shifting of a manual transmission comprising an electronic control unit 31 for varying an actual engine fueling to achieve a zero torque by an operator's request for torque elimination, the torque being controlled as a function of the engine fueling, and the driver is then easily able to shift into neutral. A manually shifted transmission 30 has an input shaft 37 driven by the engine, and output shaft 38, a yoke 40 and a collar 41 for selecting a driving ratio and a neutral position. A manually operated stick shift lever

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22 allows the operator to shift the transmission according to a predetermined pattern. See col. 7, line 51- col. 9, line 49.

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 6 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Palmeri et al. '558 in view of Nellums et al. '070.

Palmeri discloses a combined system for assisting shifting of a manual transmission as mentioned above, but does not disclose an engine fueling for a time period upon sensing a throttle pedal position. Nellums shows a fuel control device 26 for controlling an amount of fuel to be supplied to an engine for a period of time depending on a sensing signal of a throttle pedal position and an engine rotation speed (col. 3, lines 11-51) in a control for an AMT system start from stop operation.

It would have been obvious to one of ordinary skill in this art at the time the invention was made to modify Palmeri by providing a fuel control device for controlling the amount of fuel supplied to an engine in view of Nellums because control of the engine during starting and stopping of the vehicle is required for safe operation thereof.

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12. Claims 2-5, 7, 9-13, 15, 19, 21, 25, 31-32 and 34 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

FACSIMILE TRANSMISSION

Submission of your response by facsimile transmission is encouraged. Technology Center 3600 facsimile number is **(703) 305-3597**. Recognizing the fact that reducing cycle time in the processing and examination of patent applications will effectively increase a patent's term, it is to your benefit to submit responses by facsimile transmission whenever permissible. Such

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submission will place the response directly in our examining group's hands and will eliminate Post Office processing and delivery time as well as the PTO's mail room processing and delivery time.

For a complete list of correspondence **not** permitted by facsimile transmission, see MPEP 502.01.

In general, most responses and/or amendments not requiring a fee, as well as those requiring a fee but charging such fee to a deposit account, can be submitted by facsimile transmission.

Responses requiring a fee which applicant is paying by check **should not be** submitting by facsimile transmission separately from the check.

Responses submitted by facsimile transmission should include a Certificate of Transmission (MPEP 512). The following is an example of the format the certification might take:

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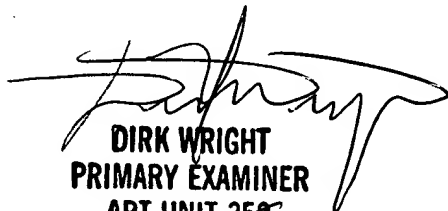
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If your response is submitted by facsimile transmission, you are hereby reminded that the original should be retained as evidence of authenticity (37 CFR 1.4 and MPEP 502.02). Please do not separately mail the original or another copy unless required by the Patent and Trademark Office. Submission of the original response or a follow-up copy of the response after your response has been transmitted by facsimile will only cause further unnecessary delays in the processing of your application; duplicate responses where fees are charged to a deposit account may result in those fees being charged twice.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dirk Wright whose telephone number is (703) 308-2160.


DIRK WRIGHT
PRIMARY EXAMINER
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dw

May 7, 1998